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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY
P.O. BOX 2938
MINNEAPOLIS MN 55402

In re Application of
GROSSFELD et al.

Application No.: 10/562,459

: DECISION ON PETITION

PCT No.: PCT/US04/14997

Int. Filing Date: 12 May 2004

: UNDER

Priority Date: 03 July 2003

Attorney Docket No.: 2043.059US1

: 37 CFR 1.497(d)

For: METHOD AND SYSTEM FOR
MANAGING DATA TRANSACTION
REQUESTS

This decision is in response to applicants' "REQUEST TO CORRECT INVENTORSHIP PURSUANT TO 37 C.F.R. 1.497(d)" filed in the United States Patent and Trademark Office (USPTO) on 29 December 2005.

BACKGROUND

On 12 May 2004, applicants filed international application PCT/US04/14997, which designated the United States and claimed a priority date of 03 July 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 03 February 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 January 2006.

On 29 December 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee, a declaration of inventors, and the instant "REQUEST TO CORRECT INVENTORSHIP PURSUANT TO 37 C.F.R. 1.497(d)".

DISCUSSION

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the

execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Applicants have satisfied item (1).

As to item (2), the processing fee of \$130 has been charged to Deposit Account 19-0743.

As to item (4), a new declaration is not required by 37 CFR 1.497(f) in the instant situation.

Applicants have not satisfied item (3). The written consent of the assignee does not contain documentary evidence of a chain of title from the original owner to the assignee. See MPEP § 324 for a proper showing under 37 CFR 3.73(b).

Declaration of Inventors

The declaration of inventors filed 29 December 2005 is not in compliance with 37 CFR 1.497(a)-(b). There is a difference in names in two of the named inventor between the published international application (Randy Wigginton and Chris Kasten) and the declaration of inventors (Kenneth Randall Wigginton and Christopher J. Kasten, respectively). Because this difference in names is more than a mere typographical error or a phonetic misspelling of each of applicant's legal names, a proper petition under 37 CFR 1.182 is required for each inventor in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of \$400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED** for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,

Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459